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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,838	01/04/2001	Kazunori Kondo	53859USA2A.0	2568

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,838

Applicant(s)

KONDO ET AL.

Examiner

Lakshmi S. Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt of RCE dated 4-10-06 is acknowledged.

Claims 9-16 are pending in the instant application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-10-06 has been entered.

The following new rejections have been applied:

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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1. Claims 9-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of US 6,638,611 ('611) and over claims 1-36 of US 6,773,718 ('718). The conflicting claims are not identical, however, they are not patentably distinct from each other. Patents '611 and '718 claim a package comprising multiple oil absorbing wipes suitable for wiping user's skin or hair, the wipes comprising oil absorbing porous film of thermoplastic material. The porosity, interstitial thickness and void volume of the film material (of both sets of claims) are same as that claimed in the instant claims. The package of '611 & '718 further comprises a surfactant (reads on the instant liquid absorbing substance). Above patents also claim mineral oil as filler that is also claimed in the instant. The sheets of above patented claims are used for oil absorption from skin and therefore, the instant method of removing facial oil is anticipated by the patent claims.

2. Claims 9-16 are directed to an invention not patentably distinct from claims 1-28 of US 6,638,611 ('611) and over claims 1-36 of US 6,773,718 ('718), both of which are commonly assigned. Specifically, the above patents also claim multiple oil absorbing wipes suitable for wiping user's skin or hair, wherein the wipes comprise oil absorbing porous film of thermoplastic material. The porosity, interstitial thickness and void volume of the film material (of both sets of claims) are same as that claimed in the instant claims. The package of '611 & '718 further comprises a surfactant (reads on the instant liquid absorbing substance). Above patents also claim mineral oil as filler that is also claimed in the instant. The sheets of above patented claims are used for oil absorption

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from skin and therefore, the instant method of removing facial oil is anticipated by the patent claims.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned US 6,638,611 ('611) and US 6,773,718 ('718), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claim Rejections - 35 USC § 103

3. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,042,844.

'844 teach a sheet pack having moisture-permeable support including a hydrophobic layer and a hydrophilic layer and a cosmetic substance. '844 teach that the hydrophobic layer is made of polyester, polyethylene or polypropylene, having a film diameter and thickness in the range of 49-55 microns (col. 4, lines 33-47 & col. 6, lines 1-13), all of which are also used in the instant invention to prepare the claimed stretched film material. '844 teach porosity of the film in the range of 70-99% (col. 5). '844 suggest adding oil or wax material as filler in the film material or sheet (col. 8, lines 50-67; col. 7, lines 55 through col. 8, lines 8). '844 suggest several uses for the sheet pack, including absorption of sebum (col. 8, lines 8-13). '844 differ from the instant claims in the absence of the claimed void sizes or interstitial volume. However, '844 suggest the same porous materials; with the film thickness in the same range as also claimed and further suggest the claimed use. '844 teach removal sebum, which includes removal of fatty material and thus reads on removal of oil. Accordingly, in the absence of any unexpected advantage with the claimed void size and interstitial volume, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have an optimum void size and interstitial volume, depending on the amount of filler added on the film that is used for removing or cleaning sebum, with an expectation to achieve an effective removal of sebum (as well as oils) from the surface. The ability of

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the sheets to become transparent is implicit to the film material of '844 because '844 teach the same materials as claimed.

4. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,532,937 to ('937) in view of US 6,042,844.

'937 teaches a sebum collecting means from the skin of a subject, wherein the means comprises an open-celled, microporous, hydrophobic polymeric film substrate for application to the skin (col. 2, lines 57-65 & col. 3, L 34-48). The microporous film of '937 is made of a nonwoven material such as a polyester, polyolefin etc., that have the capacity to absorb sebum (col. 3, L 51-68) and have a pore volume of 25% to 50% (within the range cited in claim 11) and a thickness of 0.01 mm to 0.05 mm (within the range cited in claim 11) (col. 4, lines 1-14). '937 teach that the film is opaque or translucent before absorption and turns more translucent or transparent upon absorbing sebum (col. 4, L 1-14 and col.5, L 1-13). While '937 does not specify the void volume of the pores as claimed, the porous film disclosed by '937 has a pore size and film thickness in the same range as that claimed and accordingly, the film of '937 possesses the claimed void volume and interstitial volume (a function of film thickness and void volume). '937 fails to teach the claimed filler material.

'844, explained above teach sheet packs, the films of which are made of the same material as that claimed. '844 suggest adding oil or wax material as filler in the film material or sheet (col. 8, lines 50-67; col. 7, lines 55 through col. 8, lines 8). '844 suggest several uses for the sheet pack, including absorption of sebum (col. 8, lines 8-

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13), which includes removal of fatty material and thus reads on removal of oil.

Accordingly, it would have been obvious to a person of ordinary skill in the art at the time of the instant invention was made to incorporate filler materials such as oils, waxes, talc etc., because Miller suggests incorporating the above efficient absorption of sebum. Therefore, one of an ordinary skill in the art would have been motivated to add the filler material of '844 in the sheets of '937 with an expectation to efficiently clean remove sebum from skin surface.

5. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,532,937 in view of US 6,042,844 as applied to claims 9-12, and further in view of GB 2061709 (submitted on PTO-1449, GB).

Instant claims recite a liquid absorbing substance partially distributed on the surface of the porous stretched film. '937 or '844 do teach distribution of a liquid absorbing substance on the oil and fat absorbing stretched, porous film material.

GB teaches a cosmetic pad for cleaning the skin or removing make-up, comprising a core of flexible, liquid –sorbent material and a covering of a stretched material on the liquid-sorbent material (abstract, page 1, lines 30-40). GB teaches a method of cleaning skin or face or make-up, comprising applying water to the pad to cause the liquid-sorbent material to absorb water and wiping the said pad over a portion of the surface to be removed or cleaned. GB teaches that the sorbent material is covered with a stretched plastic material, where as instant claim recites that is distributed on the surface of the pad. However, GB teaches the liquid-sorbent material

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i.e., for cleaning or removing make-up and thus has the same function as that of the instant. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to incorporate the sorbent material of GB into the porous film material or over the film of '937 (containing the filler material of '844) because GB suggests that upon applying water a portion of the liquid sorbent material absorbs water and expels the material that cleanses the skin or the surface being cleaned. Therefore, a skilled artisan would have expected to remove sebum from the skin surface by the absorbing capacity of the microporous film ('937) and also cleanse the skin from dirt or remove the make-up at the same time from the skin surface.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,042,744 as applied to claims 9-12 above, and further in view of GB 2061709 (submitted on PTO-1449).

'844 do teach distribution of a liquid absorbing substance on the oil and fat absorbing stretched, porous film material.

GB teaches a cosmetic pad for cleaning the skin or removing make-up, comprising a core of flexible, liquid –sorbent material and a covering of a stretched material on the liquid-sorbent material (abstract, page 1, lines 30-40). GB teaches a method of cleaning skin or face or make-up, comprising applying water to the pad to cause the liquid-sorbent material to absorb water and wiping the said pad over a portion of the surface to be removed or cleaned. GB teaches that the sorbent material is covered with a stretched plastic material, where as instant claim recites that is

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distributed on the surface of the pad. However, GB teaches the liquid-sorbent material i.e., for cleaning or removing make-up and thus has the same function as that of the instant. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to incorporate the sorbent material of GB into the porous film material or over the film of '844, containing the filler material, because GB suggests that upon applying water a portion of the liquid sorbent material absorbs water and expels the material that cleanses the skin or the surface being cleaned. Therefore, a skilled artisan would have expected to remove sebum from the skin surface by the absorbing capacity of the microporous film ('937) and also cleanse the skin from dirt or remove the make-up at the same time from the skin surface.

Response to Arguments

Applicant's arguments with respect to claims 9-16, presented on 3-9-06 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -6.30 PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lakshmi S Channavajjala
Examiner
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June 12, 2006